

## **REMARKS**

### **Reconsideration And Allowance Are Respectfully Requested.**

Claims 1-20 are currently pending. No claims have been amended. No claims have been cancelled. No claims have been added. No new matter has been added. Reconsideration is respectfully requested.

With regard to outstanding rejections, claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,248,342 to Trogolo et al. ("Trogolo") in view of U.S. Patent Nos. 5,931,354, 5,962,564, and 6,075,078 to Braud et al ("Braud patents"). This rejection is respectfully traversed in view of the following remarks.

Independent claims 1 and 11 respectively define a flooring plank and a method for forming a flooring plank in a manner which inhibits the growth of mold, mildew, bacteria or unwanted biological agents adjacent an underside of the flooring plank. In particular, and with reference to independent claim 1, the claims are directed to a flooring plank having a decorative upper surface and a core layer providing support and stability to the flooring plank. The core layer includes a plurality of edges adapted for engagement with adjacent flooring planks during the installation of the flooring planks. The flooring plank further includes a backing layer secured to an underside of the core layer. The backing layer comprises at least one sheet of resin impregnated paper and an antimicrobial agent acting upon unwanted biological organisms so as to inhibit the growth of mold, mildew, bacteria, or unwanted biological agents adjacent an underside of the flooring panel.

The Office Action contends the claimed flooring plank is obvious based upon the disclosures of Trogolo and the Braud patents. However, neither Trogolo nor the Braud patents consider the nuances of constructing a flooring plank as claimed in accordance with the present invention. As the Office Action properly points out, Trogolo does teach that it is known in the art to manufacture high-pressure laminates with an antimicrobial agent and then to secure the paper onto a substrate. In addition, the Braud patents do teach that it is known in the art to use an antimicrobial composition in an adhesive. However, neither of these references disclose or suggest a flooring plank having a backing layer secured to an underside thereof wherein the backing layer comprises at least one sheet of resin impregnated paper and an antimicrobial agent.

The use of the antimicrobial agents within the backing layer of the flooring plank substantially reduces the potential development of undesired biological agents adjacent the unexposed, and inaccessible, underside of the flooring plank. As those skilled in the art certainly appreciate, it is relatively easy to maintain the upper surface of a flooring plank clean and substantially free of undesirable biological agents. However, it is virtually impossible to ensure the underside of the flooring plank is maintained free of unwanted biological agents. The application of antimicrobial agents within the backing layer of the flooring plank provides a large surface for combating the undesirable biological agents in the vicinity of the flooring planks.

In establishing the law governing obviousness-type rejections, the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness,

these inquiries may have relevancy. . . This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definitiveness which Congress called for in the 1952 Act.

With the foregoing in mind, the U.S. Patent & Trademark Office has determined that a *prima facie* case of obviousness is established by meeting three basic criteria. First, the Examiner must show some suggestion or motivation to modify the reference or to combine reference teachings. Second, the Examiner must show a reasonable expectation of success in modifying the primary reference based upon the teachings of the prior art. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Support for the proposed modification and the reasonable expectation of success must be found in the prior art. MPEP 706.02(j). It has further been determined that "[w]here a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection." See *In re Hoch*, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

With the foregoing in mind, the Office Action fails to establish a *prima facie* case of obviousness based upon the disclosures of Trogolo and the Braud patents. In particular, none of the patents provide a suggestion or motivation to construct a flooring plank having a backing layer with an antimicrobial agent incorporated therein. In addition, and considering the fact that there is no suggestion or motivation for the modification necessary to meet the pending claims, there is no reasonable expectation of success in modifying Trogolo based upon Braud so as to meet the pending claims. The Braud patents disclose the utilization of an adhesive film in conjunction with fabric, textiles, wood, plastic, metals, rubber, carpets, linoleum, tiles and artificial grasses. Trogolo

discloses the utilization of a high-pressure laminate in conjunction with substrates. Neither of these address the invention claimed in the present application. In addition, and as discussed above, the prior art references must teach or suggest all the claimed limitations. Neither the Braud patents nor Trogolo disclose a flooring plank having a backing layer comprising at least one sheet of resin impregnated paper and an antimicrobial agent.

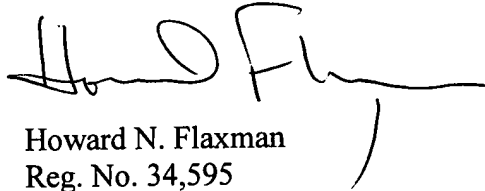
With the foregoing in mind, it is Applicants' opinion the rejection of independent claim 1 based upon the disclosures of Trogolo and the Braud patents is improper and Applicants respectfully request that the rejection be withdrawn.

As to independent claim 11, it substantially defines the method for forming the flooring plank defined in independent claim 1 and requires that a backing layer be secured to the underside of the core layer and that the backing layer comprise at least one sheet of resin impregnated paper including an antimicrobial agent. As independent claim 11 includes limitations substantially similar to those defined in independent claim 1, claim 11 is believed to overcome the prior art of record for reasons presented above with regard to independent claim 1.

As to those claims dependent upon independent claims 1 and 11, they are believed to overcome the prior art of record for the reasons presented above. Further, and with regard to claims 4, 5, 6, 7, 8, 9, 10, 14, 15, 16, 17, 18, 19, and 20, these relate to very specific components of the claimed invention. However, these limitations have not been addressed in the Office Action. If the Examiner chooses to maintain the outstanding rejection, it is respectfully requested that prior art supporting the rejection of these claims be cited.

It is believed that this case is in condition for allowance and reconsideration thereof and early issuance is respectfully requested. If it is felt that an interview would expedite prosecution of this application, please do not hesitate to contact Applicants' representative at the below number.

Respectfully submitted,



Howard N. Flaxman  
Reg. No. 34,595

WELSH & FLAXMAN LLC  
2000 Duke Street  
Suite 100  
Alexandria, VA 22314  
(703) 920-1122

Docket No. WIL-41099